DOCKET NO. 2002.01.037.WT0 **PATENT**
Customer No. 23990

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of	:	Bryan J. Moles et al.
U.S. Serial No.	:	09/992,818
Filed	:	November 14, 2001
For	:	METHOD AND APPARATUS FOR OPTIONAL AUTOMATIC CONFIGURATION OF WIRELESS COMMUNICATIONS DEVICE BEHAVIOR WITHIN SMALL AREA TRANSMITTER SERVICE REGIONS
Group No.	:	2643
Examiner	:	Tuan Pham

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal. The review is requested for the reason(s) stated in the arguments below, demonstrating the clear legal and factual deficiency of the rejections of some or all claims.

Claims 1-4, 6-8, 10-15, 17-19 and 21-26 were each rejected in the December 1, 2005 final Office Action as being obvious over United States Patent No. 6,625,455 to Ariga (hereafter, "Ariga") in view of United States Patent Application Publication No. 2002/0142792 to Martinez (hereafter, "Martinez"), and further in view of United States Patent No. 6,907,254 to Westfield (hereafter, "Westfield"). These rejections are legally and factually deficient in that various claim limitations are not found in the art at all, Examiner Pham mistakes the teachings of the art, and there is no proper motivation to combine these references.

In his Advisory Action, Examiner Pham indicated allowable subject matter in claims 11, 22, 24, and 26, and objected to these as depending from a rejected base claim. Applicant thanks Examiner Pham for the indication of allowable subject matter, but respectfully maintains that the remaining rejections are in error.

Claim 1 requires, among other limitations a system for receiving a behavior set from the small area transmitter, automatically sets operation of the wireless device to conform to the behavior set and associated user preferences, and upon detecting unavailability of the behavior service following previous availability of the behavior service, automatically restores operation of the wireless device to a state existing prior to automatic setting of the operation of the wireless device to conform to the behavior set and associated user preferences." (Emphasis added). These limitations of Claim 1 are not disclosed, suggested, or even hinted at in Ariga, Martinez, Westfield, or any combination of them.

The Ariga reference describes a portable telephone system wherein a portable telephone entering a building is instructed by a simple base station device to turn power off to its radio section.

See Ariga, col. 3, lines 39-54. When the portable telephone goes out of the building, the simple base station device instructs it to turn power on to its radio section. See Ariga, col. 3, line 64, through col. 4, line 7. Only a single command value (01h) is sent, which is interpreted by the portable telephone as a 'power off' command when entering the building in a powered-on condition, and as a 'power on' command when going out of the building in a powered-off condition. See Ariga, Figure 4, col. 5, lines 4-10. Nothing in Ariga teaches or suggests the limitations above.

Martinez discloses cellular telephones that allow a user to define operational settings (such as ring on/off, vibrate on/off, ring loud/soft) and store the settings as user preference information. Entry of the telephone into a private network causes the selection of user preferences entered by the user, rather than preferences received from the private telephone network. Upon re-entering the public network, the telephone selects user preferences associated with the public network, rather than restoring preferences in use before the telephone entered the private network. Nothing in Martinez teaches or suggests the limitations above.

Examiner Pham has expressly conceded that the combination of Ariga and Martinez does not teach or suggest receiving a behavior set from the small area transmitter, and so relies on Westfield. Examiner Pham makes a clear factual error by statin that Westfield teaches "a wireless device, upon detecting the behavior service upon entering the service area and receiving a behavior set from the small area transmitter", as required by claim 1, and that it does so in col. 6, lines 2-42.

This passage describes a method of enforcing a quiet zone by putting phones in the quiet zone into a quiet mode. When a phone enters the "quiet zone", a central facility receives an IP message

that identifies the phone and sends a hushing command to the phone to go into a quiet mode, preferably by sending an IP message to the base station, which relays it to the phone.

As described in this passage of Westfield, the wireless does not receive a behavior set from a small area transmitter, rather, it receives an "IP message" from a "central facility", which is a base station (col. 6, line 38) or preferably a switching center (col. 6, line 33), and not from a "small area transmitter". As described in the specification as filed, the claimed "small area transmitter" can be, e.g., a Bluetooth or similar transmitter. Such transmitters have very limited transmission distances, hence "small area". No reasonable interpretation of the current claims could include a mobile switching center or base station of a cellular wireless communication system as described in Westfield. The Examiner's reliance is therefore a clear legal and factual deficiency of the present rejection.

Further, this "IP message" is alternately described as "causing [the phone] to change behavior" (col.2, line 36), "an IP message that can include a hushing command" (col. 2, line 52), "an IP message is sent to the cellular phone device that includes notification that the cellular phone devices has entered a quiet zone" (col. 3, lines 6-9). None of these descriptions teaches or suggests at all that the "IP message" is a "behavior set" as claimed, illustrating another factual deficiency of the final rejection.

As Westfield does not teach these claim limitations, and Examiner Pham has conceded that these limitations are not taught or suggested in the other art of record, no combination of the cited art teaches or suggests the plain limitations of claim 1. Independent Claims 3, 7, 12, 14 and 18 include similar features, as do all dependent claims, and are similarly distinguished over all art of record.

Further, there is no proper motivation to incorporate the teachings of Westfield into the system described by Ariga, as it would simply be inoperable. Ariga describes that the phone is turned off when it enters the restricted zone. It would be utterly pointless to then add, according to Westfield, that the mobile switching center or base station should also send it a "hushing command." Lack of a proper motivation to combine these references, even if they together taught the limitations of the claims (which they do not), illustrates the legal deficiency of the obviousness rejections.

As described above, Examiner Pham's rejections of all claims are both legally and factually deficient, and it would therefore be inappropriate to put the Applicant to the time and expense of an appeal at this time.

As a result of the foregoing, the Applicant asserts that the claims in the Application are in condition for allowance over all art of record, and respectfully requests this case be returned to the Examiner for allowance or, alternatively, further examination.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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Date: 1 March 2006

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